

### **REMARKS/ARGUMENTS**

Applicants have carefully reviewed the Office Action mailed on November 30, 2004. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1-50 and 52-58 remain pending.

#### **Rejections Under 35 U.S.C. §102**

Claims 43-50, 52, and 53 are rejected under 35 U.S.C. §102(e) as being anticipated by Rooney et al. in U.S. Patent No. 6,306,105. Independent claims 43 and 47 each recite a core wire having a proximal portion and a distal portion, a coil having a proximal region and a distal region, the proximal region of the coil connected to the distal portion of the core wire, and the distal region of the coil extending distally beyond the distal portion of the core wire. Rooney et al. does teach a coil 30 attached to a core wire 20, but does not seem to teach or suggest that the proximal portion of the coil is connected to the distal portion of the core wire.

Furthermore, claim 43 now recites that the polymer sheath extends proximally beyond the proximal region of the coil and also extending distally beyond the distal portion of the core wire and the distal region of the coil to form a tip. Claim 47 now recites that the outer structure extends proximally beyond the proximal region of the flat wire coil and also extending distally beyond the distal portion of the core structure. Rooney et al. does not seem to teach or suggest such structure. Because of these structural distinctions, Rooney et al. cannot anticipate claims 43 and 47 or claims 44-46 and 50, 52, and 53, respectively, depending therefrom. Applicants respectfully submit that these remarks overcome the rejection under 35 U.S.C. §102(e).

#### **Rejections Under 35 U.S.C. §103**

Claims 1-13, 16, 20-28, 30, and 33-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over EP 806220 A2 to Eder et al. (hereinafter “Eder et al.”) in view of U.S. Patent No. 5,238,004 to Sahatjian et al. (hereinafter “Sahatjian et al.”). The Examiner indicated that Eder et al. discloses all of the claim limitations except for a distal guidewire section that is formed of a linear elastic nickel-titanium alloy. The Examiner then indicated that it would be an obvious design choice to form the superelastic nickel-titanium alloy distal

section of a guidewire of a linear elastic nickel-titanium alloy in view of the teachings of Sahatjian et al.

The Applicants respectfully disagree with this assertion, and submit that a *prima facie* case of obviousness has not been properly established at least for the reason that there is no motivation to combine the cited references. The nature of the problem solved, the teachings of cited art, and the knowledge of persons of ordinary skill in the art would not provide the necessary motivation to combine the cited references to arrive at the claimed invention. The nature of the problems and solutions discussed by Sahatjian et al. varies greatly from those of Eder et al. Furthermore, Eder et al. and Sahatjian et al. teach away from each other by proposing the use of very different materials to address very different problems. As such, applicants respectfully submit that the claims as originally presented are allowable over Eder et al. and Sahatjian et al. either alone or in combination.

Furthermore, independent claims 1, 35, and 39 now recite a connector comprising a nickel-chromium alloy, a nickel-molybdenum alloy, or a cobalt alloy. Additionally, independent claim 25 now recites a connector comprising a metal alloy having a Unified Numbering System (UNS) designation of N006625 or N10276, or a nickel-molybdenum alloy designated B-2. Independent claim 40 recites that the joining means includes a connector member comprising a metal or metal alloy different from the metal or metal alloy of the proximal section and different from the linear elastic nickel-titanium alloy of the distal section. Independent claim 42 recites a connector comprising a nickel-chromium-iron alloy which connects the proximal and distal sections. The use of a connector comprising the materials as claimed in any of these claims independently is not taught or suggested by Eder et al. or Sahatjian et al. either alone or in combination. As such, applicants respectfully submit, for at least these reasons, independent claims 1, 25, 35, 39, 40 and 42, and the claims that depend there from, are allowable over Eder et al. and Sahatjian et al., and as such, request withdrawal of the rejection.

Claims 14, 15, 17-19, 29, 31, 32, 54, and 57 are rejected under 35 U.S.C. §103(a) as being unpatentable over Eder et al. in view of Sahatjian et al. and further in view of Gambale et al. in U.S. Patent No. 5,144,959.

Claims 14, 15, 17-19 are dependent upon independent claim 1, and claims 29, 31, 32 are dependent on independent claim 25. As such, these claims are allowable over Eder et al. and Sahatjian et al. for the reasons discussed above, and because Gambale et al. fails to cure the deficiencies identified above.

As described above, there is no adequate motivation to combine the teaching of Eder et al. with Sahatjian et al., and Gambale et al. fails to cure this. Furthermore, independent claim 1 recites a connector comprising a nickel-chromium alloy, a nickel-molybdenum alloy, or a cobalt alloy, and independent claim 25 now recites a connector comprising a metal alloy having a Unified Numbering System (UNS) designation of N006625 or N10276, or a nickel-molybdenum alloy designated B-2. The use of a connector comprising the materials as claimed in each of these claims is not taught or suggested by Eder et al. or Sahatjian et al. either alone or in combination, and Gambale et al. does not provide the necessary elements. As such, a *prima facie* case of obviousness does not exist, and applicants respectfully request the withdrawal of the rejection of these claims.

With regard to the rejection of independent claim 54 and dependent claim 57 on these grounds, again, there is no adequate motivation to combine the teaching of Eder et al. with Sahatjian et al., and the addition of Gambale et al. fails to cure this. Furthermore, independent claim 54 recites the connector comprising a nickel-chromium alloy, a nickel-molybdenum alloy, or a cobalt alloy, the connector being welded to at least the distal section. Again, neither Eder et al. nor Sahatjian et al., either alone or in combination, teach or suggest a connector comprising the materials and structure as recited, and Gambale et al. does not add the necessary elements. As such, a *prima facie* case of obviousness does not exist, and applicants respectfully request the withdrawal of the rejection of these claims.

Claims 54-56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richardson et al. in U.S. Patent No. 6,673,025 in view of Eder et al., and further in view of Sahatjian et al. Again, as described above, there is no adequate motivation to combine the teaching of Eder et al. with Sahatjian et al., and Richardson et al. does not cure this. Furthermore, as discussed above, independent claim 54 recites the connector comprising a nickel-chromium alloy, a nickel-molybdenum alloy, or a cobalt alloy, the connector being welded to at least the distal section. Again, neither Eder et al. nor Sahatjian et al., either alone

or in combination, teach or suggest a connector comprising the materials as recited, and Richardson et al. does not add the necessary elements. As such, a prima facie case of obviousness does not exist, and applicants respectfully request the withdrawal of the rejection of these claims.

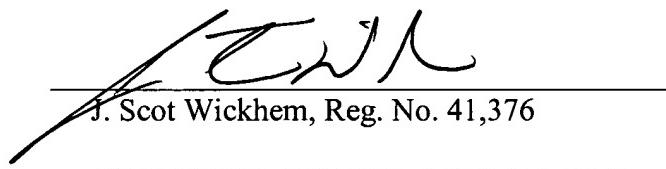
Claim 58 is rejected under 35 U.S.C. §103(a) as being unpatentable over Richardson et al in view of Eder et al. and Sahatjian et al., and further in view of Sepetka et al. in U.S. Patent No. 4,832,047. As described above, there is no adequate motivation to combine the teaching of Eder et al. with Sahatjian et al. and the combination of Richardson et al. (which is not conceded as being proper) with either Eder et al. or Sahatjian et al., alone, is not sufficient to disclose or teach each and every element of claim 54. Sepetka et al. fails to cure this deficiency. Therefore, claim 54 is believed to be in condition for allowance. Because claim 58 depends from claim 54 it is patentable based on these remarks and because it adds significant elements to distinguish it from the prior art.

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,  
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By their attorney,

Date: February 28, 2005



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